

Application Number 09/963,806  
Responsive to Final Office Action mailed June 30, 2005

### REMARKS

In this Amendment, Applicants have amended claims 1, 11, 14, 16, 20, 29, 34, 38, 40-44, 46, 47, 50, and 51. In addition, Applicants have canceled claims 10, 13, 19, 31, 37, 39, 48, and 49. Claims 1-9, 11-12, 14-18, 20-30, 32-36, 38, 40-47, and 50-66 are now pending.

#### Allowable Subject Matter

The Examiner indicated that claims 10, 13, 14, 19, 31, 32, 37, 39-51, 53-63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, the Examiner indicated that claims 52, 65-66 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. § 112, second paragraph.

Applicants have amended claim 1 to include the limitations of allowable dependent claim 10, amended independent claim 11 to include the limitations of allowable dependent claim 13, amended claim 16 to include the limitations of allowable dependent claim 19, amended claim 29 to include the limitations of allowable dependent claim 31, amended claim 34 to include the limitations of allowable dependent claim 37, amended claim 38 to include the limitations of allowable dependent claim 39. Applicant also has rewritten claims 43, 44, 46, 47, 50 and 51 in independent form. In addition, Applicants have amended claim 20 to recite limitations similar to those recited in claim 21. Accordingly, claim 20 should be allowable for the same reasons as claim 1. Upon entry of the amendments, all of the claims should be in condition for allowance.

Applicants have not amended claims 52, 65 and 66. However, Applicants have provided clarifying remarks below. In view of the clarifying remarks, claims 52, 65, and 66 should be found to meet the requirements of 35 U.S.C. § 112, second paragraph. Therefore, claims 52, 65 and 66 should be allowable.

#### Claim Rejection Under 35 U.S.C. § 112

In the Final Office Action, the Examiner rejected claims 38, 52, 64-66 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner noted a perceived discrepancy between remarks submitted by Applicant with the previous Amendment filed April 4, 2005, and the content of claims 38, 52 and 64-66. In the previous

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Amendment, Applicant stated that certain claims require that output provided in a format describing a type of the output is obtained from a router.

The Examiner stated that the claims actually specify that such output is received from a component of a router device. For purposes of clarification, Applicant acknowledges that claims 38 and 64 each specify that a "router system module" provides output in a format that describes a type of the output. Claim 52 refers to a system module of a routing device that provides a numeric address to the client interface in a self-describing format. Claim 65 refers to a system module that provides a numeric address in a self-describing format. Claim 66 refers to a system module that provides an XML-tagged IP address.

In view of the plain language of claims 38, 52, and 64-66, and the foregoing remarks, the subject matter which Applicant regards as the invention in such claims is clear. Accordingly, Applicant respectfully requests withdrawal of the rejection under section 112, second paragraph.

#### **Claim Rejection Under 35 U.S.C. § 101**

The Examiner rejected claims 20, 29 and 34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In support of the rejection, the Examiner stated that claims 20, 29 and 34 "are not limited to tangible embodiments." The Examiner cited Applicants' disclosure as describing a computer-readable medium that is not limited to tangible embodiments, but rather "defined as include tangible embodiments (e.g., computer storage media) and intangible embodiments (e.g., modulated data signal, such as carrier wave." On this basis, the Examiner concluded that claims 20, 29 and 34 are not "limited to" statutory subject matter. Applicant respectfully traverses this rejection for at least the reasons expressed below..

Applicants are unaware of any authority for the proposition that claims are nonstatutory if they are "not limited to tangible embodiments." The case law cited in the Office Action does not appear to be relevant to the issue at hand. To the extent such case law is relevant, it seems to cut contrary to the proposition for which it is cited. In the case of *In re Schrader*<sup>1</sup>, the Court addressed whether a transformation of subject matter for compliance with 35 U.S.C. 101 under the Freeman-Walter-Abele analysis would require transformation of tangible subject matter. The Court found that changes to either tangible subject matter or intangible subject matter

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<sup>1</sup> 30 USPQ2d 1455, 1459 (Fed. Cir. 1994).

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representative of or constituting physical activity or objects would suffice. The Court in *In re Warmerdam*<sup>2</sup> reinforced the point made by *In re Schrader*.

Hence, the issue in *In re Schrader* and *In re Warmerdam* addresses the sufficiency of process steps for purposes of section 101, and does not seem to relate to the status of computer-readable media claims. There is nothing in these two cases, or any other authority of which Applicant is aware, that would specify that a computer-readable medium claim is statutory "unless the specification defines 'computer readable medium' as including intangible media" (emphasis in original). Indeed, a review of granted U.S. patents should reveal numerous instances in which claims cast in terms of intangible media have been allowed. Moreover, it is clear that Applicants' claims encompass embodiments relating to tangible media. Even if legal theory advanced in the Office Action were applicable, it is unclear why a claim that encompasses tangible media would be non-statutory if it also encompasses intangible media.

In the remarks accompanying the section 101 rejection, the Examiner also referred to claims 32, 52 and 58. It is unclear whether the Examiner was rejecting those claims. The Examiner stated that "although the preamble recites an apparatus (e.g., routing device), the elements/features of the claimed apparatus are not necessarily implemented in hardware" and that "the claim is a [sic] best directed toward and [sic] arrangement of software per se." On this basis, the Examiner concluded that the claims are not "tangibly embodies [sic], and is therefore non-statutory."

Claim 32 is dependent, via claim 31, on claim 29, which recites a processor-readable medium. Hence, claim 32 likewise is directed to a processor-readable medium. Therefore, the Examiner's statement concerning implementation in hardware seems to be inapplicable to claim 32.

Claim 52 recites a routing device comprising a client interface and a system module. The question of whether such features are implemented in hardware or software is immaterial to the issue of statutory subject matter. Claim 52 recites a routing device and specifies particular features of the device that contribute to a concrete, useful and tangible result, i.e., processing of an operational request from a network router client and resolution of numeric addresses to symbolic names. Similarly, claim 58 recites a routing device and specifies features that support

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<sup>2</sup> 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

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processing of an operational request from a network router client, and resolution of IP addresses to symbolic names. There is no basis for concluding that claims 52 and 58 are directed to software per se. Rather, claims 52 and 58 are directed to statutory machines.

In view of the clear recitation of statutory subject matter in claims 20, 29, 34, 32, 52, and 58, and the foregoing remarks, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 101.

#### **Claim Rejections Under 35 U.S.C. §§ 102 and 103**

Applicant respectfully traverses the rejections under sections 102 and 103. The prior art fails to disclose or suggest the requirements of Applicants' claims. To expedite prosecution toward immediate allowance, however, Applicants have amended all of the claims to recite subject matter indicated to be allowable by the Examiner. Accordingly, Applicants reserve further comments concerning the prior references applied by the Examiner. However, Applicants do not acquiesce in the propriety of either the rejections or the Examiner's characterization of the prior art or interpretation of Applicants' claims. Rather, Applicant reserves the right, in any future continuation, to pursue claims similar in scope to those rejected in the Office Action.

Although Applicants reserve comments on the legitimacy of the prior art references, Applicant points out that some of the section 102(b) rejections should have been designated as rejections under section 102(e). For example, the Mwikalo patent, granted November 12, 2002, does not qualify as prior art under section 102(b), but rather 102(e), in view of the filing date of the present application, September 25, 2001. Likewise, the White et al. patent does not qualify as 102(b) art, in view of its grant date of March 23, 2004. In addition, the patent to Abjanic was published May 4, 2004, and therefore qualifies as prior art under section 102(e), rather than 102(b).

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### CONCLUSION

All claims in this application are in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

9-30-05

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